REMARKS/ARGUMENTS

Claims 16-28 are pending in the application, with claims 25-28 having been previously withdrawn. Claims 16-24 were examined and rejected. Reconsideration of the claims is respectfully requested.

Claim Rejections - 35 U.S.C. §103(a):

Claims 16-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 7,137,993 to Acosta et al. ("Acosta") in view of U.S. Patent No. 5,201,757 to Heyn et al. ("Heyn"). Such rejections are traversed for at least the following reasons.

The Office Action indicates that Acosta is not disqualified as prior art under § 103 because the effective filing date of Acosta is March 13, 2002 (based on U.S. Provisional Patent Application No. 60/364,389) which is more than 1 year before the October 14, 2003 filing date of the present application (Office Action, page 3). Applicants respectfully disagree with this analysis.

While Applicants acknowledge that Acosta claims priority back to U.S. Provisional Patent Application No. 60/364,389 and therefore Acosta has an effective filing date of at least March 13, 2002, the 1 year period is not relevant to an obviousness rejection under 35 U.S.C. § 103(a) based on a § 102(e) reference. The 1 year time period is only relevant to rejections using 35 U.S.C. §§ 102(b) and 102(d) references.

Rejections under § 102(b) relate to inventions patented or described in a printed publication. Since Provisional Patent Application No. 60/364,389 never issued as a patent nor was it ever published, § 102(b) does not apply. Moreover, § 102(d) relates to an invention first patented in a foreign country. U.S. Provisional Patent Application No. 60/364,389 was not a foreign patent and therefore § 102(d) also does not apply.

If the Examiner maintains that Acosta's effective filing date is the March 13, 2002 filing date of U.S. Provisional Patent Application No. 60/364,389 then the Examiner is classifying Acosta as a §102(e) reference. Applicants assert that Acosta, a § 102(e) reference

cannot be used in combination with another reference to reject the claims under § 103(a) because Acosta should be disqualified pursuant to 35 U.S.C. § 103(c)(1).

Pursuant to 35 U.S.C. § 103(c)(1), Acosta cannot be used to render any of the pending claims obvious, since Acosta was owned by the assignee of the present application at the time of filing. The American Inventors Protection Act of 1999 ("AIPA") amended 35 U.S.C. § 103(c)(1) to add that subject matter that only qualifies as a reference under 35 U.S.C. § 102(e) and that was commonly owned, or subject to an obligation of assignment to the same person, at the time the invention was made cannot be applied in a rejection under 35 U.S.C. § 103(a). Specifically, 35 U.S.C. §103(c)(1) states:

> "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of 35 U.S.C. § 102, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." (Emphasis Added).

The criteria for establishing common ownership is articulated in the MPEP. The relevant section recites:

> The term "commonly owned" is intended to mean that the subject matter which would otherwise be prior art to the claimed invention and the claimed invention are entirely or wholly owned by the same person(s) or organization(s)/business entity(ies) at the time the claimed invention was made. (MPEP 706.02 (l)(2); Emphasis Added).

According to the AIPA § 4807(b), §103(c) applies to any patent application filed on or after the date of enactment, November 29, 1999. Here, the present application was filed on October 14, 2003 (i.e., after November 29, 1999) so that the changes to § 103(c) made by the AIPA apply to this application. Acosta is a reference under § 102(e) because Acosta was filed on March 13, 2003, was published as U.S. Patent Application Pub. No. 2004/0093061 A1 on May 13, 2004, and issued as U.S. Patent No. 7,137,993 B2 on November 21, 2006. Acosta and the present application were also commonly owned or subject to assignment to the same person at the time that the invention of the present application was made. In this regard, the undersigned, an attorney of record states:

U.S. Patent Application No. 10/686,025 and U.S. Patent No. 7,137,993 were, at the time the invention of U.S. Patent Application No. 10/686,025 was made, owned by Xtent Inc. of Menlo Park, California or subject to an obligation of assignment to Xtent Inc.

In support of this statement, assignment of U.S. Patent No. 7,137,993 to Xtent, Inc. was executed on August 12, 2003 and was recorded under reel/frame 013960/0962. Similarly, assignment of the present application 10/686,025 to Xtent, Inc. was executed on August 5, 2004 and was recorded under reel/frame number 014977/0283.

In sum, because Acosta is only a reference under 35 U.S.C. § 102(e) and because Acosta and the present application were commonly assigned or subject to assignment to the same person at the time of the invention, Acosta cannot be used to render the claims obvious pursuant to 35 U.S.C. § 103(c)(1). Accordingly, Applicants respectfully request that the pending obviousness rejection of claims 16-24 under 35 U.S.C. § 103(a) be withdrawn and claims 16-24 be allowed.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

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